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No. 91-971

Supreme Court, U.S.
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IN THE
Supreme Court of the United States
OCTOBER TERM, 1991

Two PESOS, INC.,
Petitioner,
v.
TACO CABANA INTERNATIONAL, INC., *et al.*,
Respondents.

On Writ of Certiorari to the United States
Court of Appeals for the Fifth Circuit

**RESPONSE OF PETITIONER TO MOTION OF
RESPONDENTS TO DISMISS THE WRIT AS
IMPROVIDENTLY GRANTED**

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PETITION FOR CERTIORARI FILED OCTOBER 18, 1991
CERTIORARI GRANTED JANUARY 27, 1992

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I. Summary of the Argument

Respondents' Motion to Dismiss should be denied because:

1. Respondents' motion is an untoward effort to obtain an unjustified repolling of the members of this Court on the Court's grant of the Petition for a Writ of Certiorari in this case,
2. Respondents misunderstand the scope and nature of the conflicts between the Circuits which are presented by this case,

3. Respondents' motion is clearly and unequivocally precluded by the history and language of Rule 15.4 of the Rules of this Court,

4. Any ground for dismissal Respondents believe is appropriate may and should be raised, not by motion, but in Respondents' Brief on the Merits,

5. Respondents are premature and presumptuous in their conclusion of improvidence because the Court has not seen Petitioner's Brief in Reply, nor has it heard oral argument in this case,

6. By the conclusion of oral argument, Petitioner will have fully joined the issues and will have addressed, and proposed a resolution to the conflicts between the circuits presented by this case,

7. Aspects of the conflicts between the circuits are presently raised and addressed in the *amicus* briefs which have been filed in this case so that, already, the Court is not without guidance on the matter,

8. No rule of this Court requires Petitioner to posit all of its normative suggestions in its Brief on the Merits when it is known that *amicus* briefs on behalf of important economic and professional interests are to be concurrently filed in the case and Petitioner seeks to avoid conflicting positions with those interests, and

9. Jurisprudential prudence augers for allowance of Petitioner's Brief in Reply and oral argument before any

judgment is made on whether the Petition for a Writ of Certiorari should be dismissed as improvidently granted.

II. Rule 15.4 Precludes Respondents' Motion to Dismiss.

Rule 15.4 of the Rules of this Court unequivocally provides that "[n]o motion by a respondent to dismiss a petition for a writ of certiorari will be received." This Rule is stated clearly and plainly, without qualification or exception. The very language of the Rule precludes the Motion of Respondents from being received by this Court.

This interpretation of the Rule is also supported by the history of the Rules. The earlier Rules of this Court — which did provide that, after a Petition for a Writ of Certiorari was granted, a respondent could move to dismiss for reasons that could not have been advanced in respondent's opposition to the petition — were repealed and the present Rules of the Court, containing no such provision and, instead, the present preclusion, were adopted. See R. Stern, E. Gressman & S. Shapiro, Supreme Court Practice ("R. Stern") § 6.37 at 393 (6th ed. 1986) where these authors state:

A respondent may not move to dismiss a petition for certiorari. All his objections, jurisdictional and others, should be inserted in his brief in opposition. Rule 22.3. Many years ago the rules provided a respondent might move to dismiss the writ for reasons not already advanced in opposition to the

granting of the writ. The present rules contain no such provision¹

The clear implication of this history as well as the precise language of the Rule is not that grounds for improvidence may not be raised, but only that they may not be raised by motion and should instead be raised in Respondents' Brief on the Merits.

III. Respondents Misunderstand the Scope and Nature of the Conflicts Between the Circuits and Other Issues Which Are Presented By This Case.

Respondents argue that the circuit conflict is no more than a conflict between the Fifth Circuit's conclusion in *Chevron Chemical Co. v. Voluntary Purchasing Groups Inc.*, 659 F.2d 695, 702 (1981), *cert. den.*, 457 U.S. 1126 (1982), which holds that a trade dress maybe inherently distinctive, without proof of secondary meaning, and the Second Circuit in *Murphy v. Provident Mut. Life Ins. Co.*, 923 F.2d 923 (2nd Cir. 1990), *cert. den.*, ___ U.S. ___, 60 U.S.L.W. 3258 (1991) and *Stormy Clime Ltd. vs. ProGroup, Inc.* 809 F.2d 971, 974 (2nd Cir. 1987), which hold that proof of secon-

¹ The authors go on to suggest, however, that "... such a motion may still be available ..." *Ibid.* This gratuitous suggestion clearly conflicts with these authors own legal analysis and is conjectured without authority or coherent rationale. Indeed, elsewhere in their treatise, they write:

Dismissing a writ of certiorari as improvidently granted appears to be a matter exclusively within the discretion of the Court, dismissals being ordered on a *sua sponte* basis. Efforts by the respondent or other party to move the Court to dismiss the writ for this reason invariably fail. See *United States Department of State v. Washington Post Co.*, 455 U.S. 936 (1982) (denial of motion to dismiss); *Insurance Corporation of Ireland v. Compagnie Des Baucates*, 454 U.S. 1078 (1981) (denial of motion to recall writ). *Id.* § 5.15 at 293.

dary meaning is required in order for a trade dress to be inherently distinctive.

The conflict is actually broader and more complex than respondents understand it to be. The Second Circuit, in *Murphy* and *Stormy Clime*, *supra*, allows inherent distinctiveness, but only where secondary meaning is proved to exist. The Fifth Circuit in *Chevron*, *supra*, also allows inherent distinctiveness, but with or without the proven existence of secondary meaning. The Fifth Circuit in this case allows inherent distinctiveness, even where secondary meaning is proved not to exist. And the Ninth Circuit in *Fuddrucker v. Doc's B.R. Others, Inc.*, 826 F.2d 837 (9th Cir. 1987), precludes the possibility of inherent distinctiveness if secondary meaning does not exist.²

It is difficult to imagine a more troubled relationship in the circuits than that which exists between inherent distinctiveness and secondary meaning. This case is the ideal vehicle to clarify that relationship as well as the proof requirements necessary to establish inherent distinctiveness. The core thrust of Petitioner's Brief on the Merits addresses the true relationship between inherent distinctiveness and secondary meaning. Petitioner's Reply Brief will address normative proof requirements, in light of not only Respondents' Brief, but also the briefs of *amicus curiae*.

Respondents' mistakenly contend that it is Petitioner's position that liability on a trade dress claim may rest either on a finding of inherent distinctiveness or a finding of secondary meaning, citing to Pet. Br. 11, 13, 17, 27 and especially 9 n. 13. However, these are

² To posit the conflict, as Respondents do, as being solely between *Chevron*, *supra*, and the Second circuit cases, while ignoring the rulings of the Fifth Circuit in the present case and thereby implying they are consistent with *Chevron*, is too obviously an acute misstatement of the problem.

in fact the liability rules under *Chevron, supra*, and some of the other cases in circuits not mentioned. These are not the normative rules Petitioner suggests. Petitioner's Brief on the Merits makes it abundantly clear that Petitioner's position generally is that inherent distinctiveness may not exist where secondary meaning does not exist. To suggest that Petitioner argues otherwise is to acutely misread Petitioner's Brief on the Merits. See Pet. Br. 9, 10, 14, 15, 15 n.6 and 18 n.11.

Petitioner does not believe, as a normative proposition, that inherent distinctiveness can exist in the absence of secondary meaning.³ This is not to suggest, as Respondents mistakenly conclude, that Petitioner believes inherent distinctiveness could be well enough found if the Jury had not made any finding on secondary meaning at all. Here, Respondents address issues of proof with which Petitioner has not yet dealt.

Respondents are also mistaken in contending that the TaCasita-Taco Cabana multiple source problem is beyond the scope of the question presented. This is so because multiple sources using the same putative mark preclude a finding of secondary meaning, and the absence of secondary meaning, in turn, precludes inherent distinctiveness. Single sourcing is essential to the existence of both secondary meaning and inherent distinctiveness. To believe the issue is beyond the scope of the question presented is to misunderstand the substance of the question.

³ Again, Respondents misunderstand where they contend Petitioner's focus is on "... the particular jury finding of inherent distinctiveness in this case. . ." (Motion at 5). The finding of inherent distinctiveness arises because of the flawed jury instruction, but the instruction on secondary meaning, pursuant to which the jury found there was none, is serviceable. It is the determined existence of inherent distinctiveness and the found absence of secondary meaning that is Petitioner's focus.

This case presents, in a fundamental way, the core legal issue raised by the Petition which is, most succinctly put, what is the relationship between inherent distinctiveness and secondary meaning and, additionally, what are the collateral proof requirements for inherent distinctiveness implied by that relationship. This is most certainly not a case specific question, as Respondents suggest (Motion at 5).

IV. Respondents Are Premature and Presumptuous in Their Conclusion That the Writ Was Improvidently Granted.

The Court has not yet seen either Respondents' Brief on the Merits or Petitioner's Reply Brief, nor has the Court heard oral argument in this case. Respondents presume not only on the prerogatives of the Court in this quarter, as is suggested by the quoted material in footnote one above, but also on what facts, law and theories future briefing and argumentation may present.

Although it is the clear purpose of a reply brief on a petition to address the arguments first raised in the brief in opposition and not to reiterate or enlarge upon the arguments made in the petition, no such limitation obtains in regard to a reply brief on the merits, especially where important economic and professional interests have concurrently filed *amicus* briefs which require consideration before more definitive normative rules are suggested regarding proof requirements in a reply. A reply brief "...can in practice — and should in any event — be used only to answer points not adequately covered in the main brief."⁴ See R.

⁴ By this standard and contrary to Rule 15.4, Respondents are getting two bites at the apple, one in the guise of their present motion and the other, by their brief on the merits.

Stern 13.12 at 567-568; cf. R. Stern 6.38 at 393. This approach is not precluded by the Rules of this Court.

Petitioner's Brief on the Merits directly addresses the substance of the conflicts between the circuits because the heart and source of that set of conflicts, in its various manifestations across the circuit cases, is the theoretical and legal relationship between the concepts of inherent distinctiveness and secondary meaning. The better and more prudent course is for the Court to hear this matter out.

VI. Conclusion.

For the foregoing reasons, Respondents' Motion should be denied as improvidently filed.

DATED this 18th day of March, 1992.

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